

JD



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,906	12/11/2003	Alexandr Pekar	RFSUNY-3672	8482
41672	7590	03/22/2005	EXAMINER	
SANDER RABIN MD JD CONVERGENT TECHNOLOGY PATENT LAW GROUP 2 IRVING PLACE TROY, NY 12180-4417			WIEKER, AMANDA FLYNN	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

<b>Office Action Summary</b>	<b>Application No.</b> 10/733,906	<b>Applicant(s)</b> PEKAR, ALEXANDR	
	<b>Examiner</b> Amanda F. Wieker	<b>Art Unit</b> 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9 is/are rejected.
- 7) ☒ Claim(s) 8 and 10-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/11/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: #300 (page 9).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the surgical tape (claims 11-14) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary

Art Unit: 3743

to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

3. The abstract of the disclosure is objected to because the phrase "The present invention is" is redundant and can be inferred from the abstract. Correction is required. See MPEP § 608.01(b).

### *Claim Suggestions*

4. In claim 8, it is suggested that "claim1" be replaced with --claim 1--.
5. In claims 11-14, at line 3, it is suggested that the article --a-- be inserted between "covering" and "Murphy eye".

### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by PCT

Publication Number WO 90/06077 to Perry.

Perry discloses an endotracheal tube introducer (18) for slidably removable disposition within an endotracheal tube (ETT; 2), said introducer having a wall defining a lumen (18 being a

Art Unit: 3743

tube; see page 4) extending between a proximal end and a distal end of said introducer, said wall having an outer diameter that is less than an inner diameter of said ETT, and said wall being circumscribed by an invertibly attached shroud (16) for distal-ward (forward) flexion (Figure 2) and proximal-ward (rearward) flexion (Figure 1). The claimed method of performing an intubation using the ETT would naturally flow from the normal use of the device, as disclosed by Perry.

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry.

Perry discloses the previously described introducer for removable disposition within an endotracheal tube, wherein the introducer has a tubular member and a shroud. Perry shows that the shroud of the introducer has a substantially frusto-conical shape extending from a first circle (noted below), in a first plane perpendicular to a longitudinal axis of said introducer, to a second circle (noted below) in a second plane parallel to said first plane, said second circle of said shroud being generally coaxial with said introducer and unattached to said introducer. Perry shows the first circle being invertibly attached to the introducer at an extrusion on the tubular member of the introducer such that the shroud can flex forward and rearward with respect to the connection, said connection forming a circumferential pivot point. Perry does not specify that the first circle coincide with a "ring" of the introducer.

However, Applicant does not disclose any significant criticality to the presence of a ring at the connection to the first circle, over a connection at an extrusion. Applicant's instant specification further allows that instead of a ring, the first circle may be connected to the introducer at an extrusion of the tubular member of the introducer.

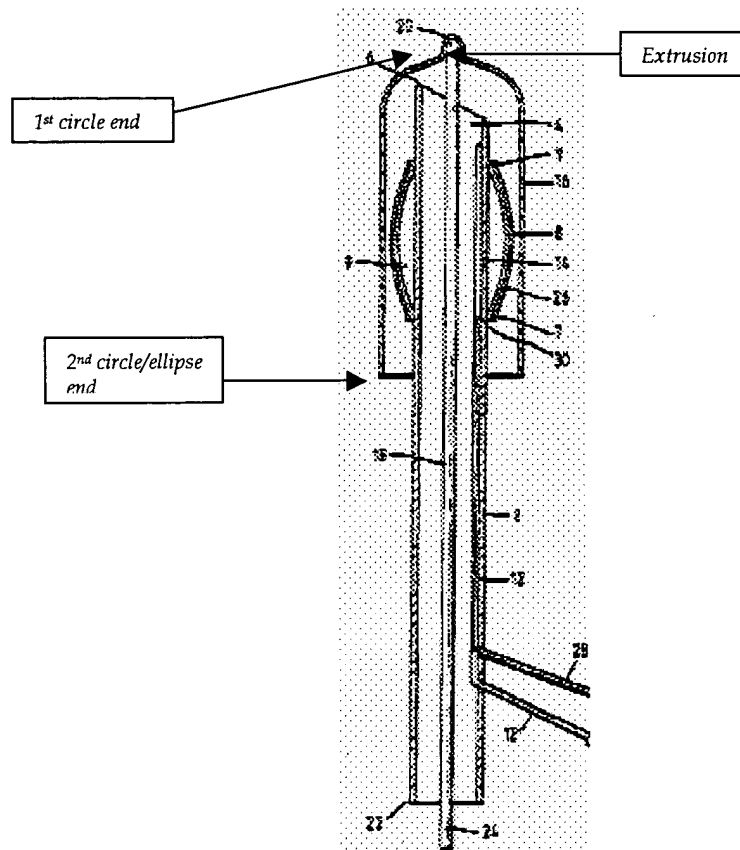
It would have been obvious to one skilled in the art at the time the invention was made to have provided the introducer as taught by Perry, wherein the first circle of the shroud is invertibly attached to either an extrusion on the introducer, or to a ring, to securely connect the shroud to the introducer, such that the shroud can flex forward and rearward with respect to the connection.

Regarding claim 5, Perry does not specify that the second end of the shroud can be an ellipse.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the second unattached end of the shroud as an ellipse because Applicant has not disclosed that shaping the end as an ellipse provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Perry's introducer, and applicant's invention, to perform equally well with either the circular-shaped end taught by Perry or the claimed ellipse-shaped end because both ends would perform the same function of allowing the shroud to be inverted over an associated endotracheal tube.

Therefore, it would have been prima facie obvious to modify Perry to obtain the invention as specified in claim 5 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Perry.

Art Unit: 3743



### *Allowable Subject Matter*

10. Claims 8 and 10-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wieker whose telephone number is 571-272-4794. The examiner can normally be reached on Monday-Thursday, 8:30 - 6:00 and alternate Fridays.

Art Unit: 3743

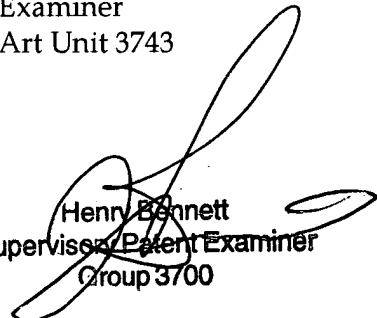
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Amanda F. Wieker  
Examiner  
Art Unit 3743

Afw



Henry Bennett  
Supervisor Patent Examiner  
Group 3700